

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB. 25, 00

Hearing:
September 1, 1999

Paper No. 17
HRW

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Johnson & Johnson

v.

Amy Quirk, Frank T. Meyer, Eric A. Weiss,
d/b/a/Adventure Medical Kits

Opposition No. 108,695
to application Serial No. 74/712,430
filed on August 8, 1995

Norm D. St. Landau of Tucker, Flyer & Lewis
for Johnson & Johnson.

Joseph L. Stabala of Law Offices of Joseph L. Stabala
for Amy Quirk, Frank T. Meyer, Eric A. Weiss,
d/b/a/ Adventure Medical Kits.

Before Hairston, Walters and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Amy Quirk, Frank T. Meyer and Eric A. Weiss, d/b/a
Adventure Medical Kits (hereinafter "applicants") filed an

application to register the mark depicted below for "first aid kits."¹

A disclaimer has been made in the application of any exclusive right to use the design of the Greek cross apart from the mark as a whole. A description of the mark has been entered defining the mark as "the design of a Greek cross in which is depicted a mountain range and a stream."

Johnson & Johnson has filed an opposition to registration of the mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and of applicants' application being void ab initio, in view of applicants' use of the Greek red cross figure in its mark in violation of 18 U.S.C. § 706. Opposer alleges use since as early as 1898 by opposer, or a related company, of a Red Cross mark for health care products; ownership by opposer of three registrations for Red Cross

¹ Serial No. 74/712,430, filed August 8, 1995, claiming a first use date of May 1987 and a first use in commerce date of December 1987.

design marks and one for the mark RED CROSS;² a likelihood of confusion of applicants' design mark with opposer's mark when both are used for wound care products, particularly in view of the fact that registration would permit applicants to use the Greek cross feature of their mark in the color red; and violation by applicants of 18 U.S.C. § 706 with use of the Greek cross feature of their mark in the color red, as registration would permit.

Applicants, in their answer, denied the salient allegations of the notice of opposition.³

The record consists of the file of the involved application and the certified status and title copies of opposer's pleaded registrations, made of record by means of

² Registration No. 54,308 for a Red Cross design mark for "medicinal and surgical plasters"; issued June 26, 1906; fourth renewal; Registration No. 1,870,955 for the mark RED CROSS for "cotton for personal use" and "sterile cotton for medical use"; issued January 3, 1995; Registration No. 1,888,143 for a Red Cross design mark for "cotton for cosmetic use"; issued April 11, 1995; and Registration No. 1,889,576 for a Red Cross design mark for "first aid kits, adhesive bandages, topical preparations for medical and therapeutic use, medical adhesive tape, gauze, sterile cotton for medical purposes, and wound dressings"; issued April 18, 1995.

³ Applicants additionally set forth affirmative defenses including laches and abandonment by opposer of its mark in view of its failure to police its mark or to abate third-party use of similar marks. The exhibits attached to the answer, however, cannot be considered as evidence in applicants' behalf, not having been identified and introduced into evidence during applicants' testimony period. See Trademark Rule 2.122(c). Accordingly, since applicants have failed to pursue these affirmative defenses in any other manner, we have given them no consideration.

opposer's notice of reliance.⁴ Neither party took any testimony and applicants made no other evidence of record. Both parties filed briefs on the case⁵ and participated in an oral hearing.

We first consider opposer's claim of likelihood of confusion under Section 2(d). Priority is not an issue, in view of the certified status and title copies of opposer's pleaded registrations which have been made of record. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Thus, we turn to the issue of likelihood of confusion, and to those of the du Pont factors which are relevant under the present circumstances.⁶

⁴ Applicants, in their brief filed January 29, 1999, renewed their earlier filed motion to dismiss under Rule 2.132(a) and objected to opposer's notice of reliance and the copies of opposer's registrations introduced thereby, in view of opposer's failure to serve the notice on applicant.

The Board, on April 20, 1999, denied applicant's original motion to dismiss under Rule 2.132(a). The renewed motion is similarly denied. Furthermore, the Board specifically noted that opposer had corrected its error in not serving applicants with a copy of the notice of reliance by later providing applicants with a copy of the same. Thus, applicants' objections to the notice of reliance on the basis of non-service are moot. Finally, the Board pointed out in footnote 1 of its order that applicants had only requested additional time to file a brief and not for the purposes of filing rebuttal evidence. Accordingly, applicants' request for the latter at oral hearing was both untimely and unwarranted.

⁵ Applicants' reply brief has been considered only as it applies to the renewed motion to dismiss. A rebuttal brief to the reply brief of opposer with respect to the opposition per se is not permitted. See TBMP § 801.02(d).

⁶ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the goods of the parties are concerned, opposer's Registration No. 1,889,576 specifically covers first aid kits, the same goods identified by applicants in their application. Most of the remaining goods recited in opposer's pleaded registrations are products for wound dressing and/or other medical use of the first aid variety. Applicants have made no argument that the goods of the parties are other than identical or closely related.

Moreover, there being no limitation in the identification of goods in either applicants' application or opposer's registrations, it must be presumed that both parties' goods would travel in all the normal channels of trade and be sold to all the usual purchasers for goods of this nature. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, for the purposes of determining likelihood of confusion, not only are the goods of the parties identical or closely related, but also it must be assumed that these goods would be marketed through the same channels of trade to the same purchasers.

The issue narrows down to whether the marks of the parties are of such a degree of similarity that confusion as to source is likely when the same potential purchasers encounter opposer's health care goods, including first aid

kits, and applicants' first aid kits bearing the following design marks:

Opposer's Red Cross
Design Mark⁷

Applicants'
Design Mark⁸

Opposer's mark is specifically lined for the color red. Applicants' mark is unrestricted as to color, other than the contrasting coloring of the mountain outline and the stream, and either the white or black portions of the mark in the drawing could be red.⁹

⁷ For purposes of our analysis, we have limited our consideration to opposer's design mark, the word mark RED CROSS being non-specific as to the form of the cross.

⁸ We note that applicants have strongly objected to the manner in which applicants' mark is depicted in opposer's brief. Applicants may be assured that the Board has taken applicants' mark under consideration as depicted in the drawing of the application, with the Greek cross being skewed in the direction shown above. We have, however, taken into consideration that applicants' mark could be colored red, as discussed infra.

⁹ Applicants' allegations in its answer and brief that the mark is stenciled on a medical kit bag and thus the mountains and the "partial" cross are the color of the bag is not supported by any evidence of record. As previously noted, the exhibits attached to the answer cannot be treated as evidence in applicants' behalf. Furthermore, even if this manner of use were supported by properly submitted evidence, the bag could be colored red. Applicants have acknowledged as much in Exhibit 1A attached to their brief.

It is well established that in general the greater the similarity of the goods, the lesser the degree of similarity of the marks which is necessary to support a conclusion that there will be a likelihood of confusion. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). When the marks involved are design marks which are not capable of being spoken, the question of the confusing similarity of the marks must be decided primarily on the basis of the visual similarity of the marks. See *In re Burndy Corp.*, 300 F.2d 938, 133 USPQ 196 (CCPA 1962). In making this determination, a side-by-side comparison is not the proper test, but rather the overall commercial impression which is created by each mark and which will be remembered by purchasers, when seeing the marks at spaced intervals. *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973).

We find the Greek cross to be the visually dominant feature in the design mark of each of the parties. Opposer's mark consists solely of that, a Greek cross colored red. While applicants' design contains other elements, namely the outline of a mountain with a stream extending to the lower part of the cross, the complete outline of a Greek cross dominates the visual impression created by the mark. We do not agree with applicants that only a partial cross is involved, in that even the stream

portion follows the shape of a Greek cross.¹⁰ Furthermore, the fact that applicants' cross is slightly skewed is far from a distinguishing factor.

Applicants argue that the mountain and stream elements of its mark cannot be ignored; they insist that it is these elements which convey to purchasers the impression of the mountain-river environment which can be traversed with safety (as denoted by the cross element) with the aid of applicants' kits. Applicants maintain that opposer's "bland red cross" does not create the "out of doors" image evoked by the mountain and stream profile elements found in applicants' mark.¹¹

If we were making a side-by-side comparison of the two design marks, the additional mountain and stream elements of applicants' mark would be obvious. This, however, is not the proper test. It is the overall commercial impression which will be recalled over a period of time which must be taken into account in determining likelihood of confusion. Opposer's mark is a simple red Greek cross, and would be remembered by purchasers as the same. As stated previously,

¹⁰ We take judicial notice of the definition of a "Greek cross" as "a cross consisting of an upright crossed in the middle by a horizontal piece of the same length." *The Random House Dictionary of the English Language*, 2nd Ed. (1987).

¹¹ We have given no consideration whatsoever to applicants' references to the results of a "straw poll" taken with respect to the impressions created by the two design marks. Applicants have made no evidence of record of any survey and have admitted as much.

the dominant portion in applicants' mark is also the Greek cross, which may also be mostly red in color. Thus, the overall commercial impressions created by the marks are very similar. Furthermore, even if the additional mountain and stream elements were recognized as a feature not found in opposer's Greek red cross, purchasers might well assume that applicants' mark is simply a variation of opposer's mark which has been adopted by opposer for use with first aid kits specifically outfitted for the "out of doors" environment.

Applicants also argue that opposer's mark is no more than a common geometric shape, a Greek cross, in the color red and thus should be accorded only a narrow scope of protection. In other words, opposer's mark is a weak mark and not entitled to protection so as to encompass applicants' particular adaptation of a Greek cross.

While opposer argues, on the other hand, that its mark is a strong and famous mark, opposer has made no evidence of record to substantiate this claim. It is true, however, that one of opposer's pleaded registrations issued in 1906. Moreover, as opposer points out, applicants have failed to produce any evidence of third-party use of similar marks. Since a statute prohibiting use of the Greek red cross was first enacted in 1905, we doubt that such evidence would ever be forthcoming. Only by being "grandfathered in" did

opposer retain the right to use the Greek red cross, apart from the specific parties protected by the statute. Thus, on the whole, we find no reason to accord opposer's mark less than the normal scope of protection.

Accordingly, in view of the fact that the marks at issue are being used on identical or very closely related goods, and of the similar overall commercial impressions created by the two design marks, we find there is a likelihood of confusion.¹²

In view of our holding under Section 2(d), we find no need to consider opposer's second ground for opposition, namely, that applicants' use of the Greek red cross in its mark is a violation of 18 U.S.C. § 706, a criminal statute, and that this unlawful use renders their application void ab initio.¹³ Furthermore, the Board has stated in the past that we will normally hold a use of a mark in commerce

¹² Applicants point to the fact that the Examining Attorney passed their application to publication with the same evidence being available. The Board, however, is under an obligation to make an independent determination on the issue of likelihood of confusion in this opposition and is in no way bound by the prior actions of the Examining Attorney. See *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341 (TTAB 1978).

¹³ 18 U.S.C. § 706 reads in pertinent part:
Whoever, whether a corporation, association or person, other than the American National Red Cross and its duly authorized employees and agents and the sanitary and hospital authorities of the armed forces of the United States, uses the emblem of the Greek red cross on a white ground, or any sign or insignia made or colored in imitation thereof ...
Shall be find under this title or imprisoned not more than six months, or both.

unlawful only when the issue of compliance has previously been determined by a court or governmental agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regulating the sale of a party's goods. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1271 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045 (TTAB 1988); and *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958 (TTAB 1981). Here a criminal statute is involved, which makes it even more imperative than any violation by applicants' be first determined by a court having competent jurisdiction under the statute.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.

P. T. Hairston

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board